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PATENT APPLICATION: **AF**
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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Daniel R. Pearson

Confirmation No.: 8727

Application No.: 09/680,069

Examiner: Pokrzywa, J. R.

Filing Date: 10/5/2000

Group Art Unit: 2622

Title: ADAPTIVE SCAN DRIVER AND SCAN PERIPHERAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in **triplicate** is the Reply Brief with respect to the Examiner's Answer mailed on 1/27/2006. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

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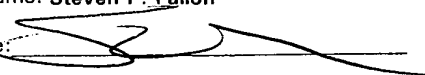
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PATENT

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REPLY BRIEF PURSUANT TO 37 CFR §§ 41.39(b)(2) & 41.41

This reply brief is filed to address the new rejection raised in the Examiner's Answer. The new rejection raises an additional issue to be reviewed on appeal. The appeal is maintained by filing this reply brief pursuant to 37 CFR § 41.39(b)(2) without amendments or additional evidence.

ADDITIONAL ISSUES TO BE REVIEWED ON APPEAL

- 1) Whether the §101 rejection of claim 1 should be reversed?
- 2) Whether the §101 rejection of claim 8 should be reversed?

ARGUMENT

I. The §101 Rejection of the Claim 1 Should Be Reversed Because the Claimed Program Does Not Define a Data Structure as Alleged in the Examiner's Answer, but Instead Defines Steps that are Necessarily Related to Functional Control of Hardware Devices.

The basis for the rejection of claim 1 under §101 is the allegation that it is directed to a data structure and, therefore, unless the “computer readable medium” phrase is used, the claim is nonstatutory. MPEP §2106 IV.B.1(a). Claim 1 does not define a data structure, however, but instead defines process steps.

MPEP §2106 IV.B.1 cites the following as the definition of a data structure: “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” In contrast, MPEP §2106 IV.B.2(b) identifies “A claim that requires one or more acts to be performed defines a process” as statutory.

Claim 1 includes a number of “acts to be performed”, including acts relating to a physical device. In the first feature of claim 1, “querying a scan peripheral for a capability descriptor” requires communication with a hardware device, namely a scan peripheral. The scan peripheral, as defined in the specification is “a scanner or multi-function device including a scanning function.” P1, L7-8. Scan peripherals can be accessed by a single machine or by multiple users over a network, for example. P1, L8-12.

Claim 1 also requires “storing a capability descriptor associated with a scan peripheral” and “configuring a scan driver for a scan job for a scan peripheral”, which are clearly process steps relating to hardware devices. There is no data arrangement or structure claimed. Accordingly claim 1 should be treated as statutory subject matter because it requires “one or more acts to be performed” on a physical device, namely a scan peripheral.

II. The §101 Rejection of Claim 8 Should Be Reversed Because Claim 8 is Directed to a Device Including Memory and a Program.

Its not at all clear how the rejection of claim 8 under §101 could be made based upon the allegation that it defines a “program”. Claim 8 includes a program, but is a device claim. Claim 8 is directed to a “scan peripheral server having a network connection interface and one or more ports for connection to at least one scan peripheral.” Claim 8 includes memory “for storing capability descriptors defining capabilities of scan peripherals.” Claim 8 also includes memory “for storing a set of driver modules.” The device of claim 8 also *includes* a particular “a program for controlling execution of scan jobs requested from the network connection of a scan peripheral connected to one of said one or more ports.”

The §101 rejection of claim 8 ignores the claim language in concluding the claim 8 is directed to “a program”. Claim 8 is directed to a device including a program, and such a device is clearly statutory. “A claim limited to a machine or manufacture, which has a practical application in the technological arts, is statutory.” MPEP §2106 IV.B.2(a).

III. The New Arguments in the Examiner’s Answer Do Not Explain Away the Clear Teachings of Lo, Which Defines an Invention that Still Makes Use of Conventional a “software or source device driver 42” which “is software which controls the image acquisition device and is written by the device developer to comply with TWAIN specifications”.

The convoluted logic in the examiner answer now attempts to assert that only the prior art described in Lo uses a conventional “software of source device driver” 42 as a scan driver. The examiner’s answer argues, on page 11, that the virtual TWAIN driver 106 is seen as “being different than what applicant argues as the driver 42.” Instead of rebutting the arguments in the appeal brief, this supports them. Applicant has argued precisely that Lo contradicts the assertion made to support the

rejection that the TWAIN driver is not “software which controls the image device” and is not “analogous to a print driver”. C5, L37-40.

Essentially, on page 11, the examiner’s answer asserts that the driver 42 in Lo only relates to the prior art devices that use conventional TWAIN drivers. This is contradicted in Lo, because it is in the description of the preferred embodiments that Lo indicates clear reliance on a conventional scan driver, establishing the virtual TWAIN driver does not take the place of, supplant, or perform the function of a scan driver. In column 5, beginning at line 31, Lo explicitly describes that the scan peripherals in the system of Lo require a “software or source device driver 42” which “is software which controls the image acquisition device and is written by the device developer to comply with TWAIN specifications”. Lo goes on to explain that “the source device driver 42 is usually written by the manufacturer of the scanner 50. The source device driver 42 may be installed in a manner which analogous to installing a print driver in a Windows based computer.” Nothing in any of the embodiments of Lo discloses constructing a scan driver according to capability descriptors and pre-stored driving modules as is required in varying scope by each of independent claims 1, 8 and 13.

The arguments by the examiner also do not explain away the improper, convoluted attempt to blur the difference between scan parameters and scan drivers. This rejection should be reversed as it is based upon an improper interpretation of the claims, and a misinterpretation of Lo. The present claims, the specification, the art, and Lo all give different, clear meaning to scan drivers that is different than scan parameters, and the Examiner’s reading of Lo’s scan parameters upon the claimed scan drive modules is accordingly unreasonable.

CONCLUSION

Regarding the rejection of claim 12, Applicant stands upon the arguments in the appeal brief, not believing that further argument is necessary. For the above reasons, and for the reasons set forth in the appeal brief, applicant requests the Board to reverse the outstanding rejections. The case should then be permitted to pass to allowance.

Respectfully submitted,

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